

REMARKS

Applicant has carefully studied the non-final Examiner's Action mailed August 17, 2005 and all references cited therein. These explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Claims 8, 9, 11 and 13 have been amended to comply with the objections cited by the Office.

Claim Rejections - 35 U.S.C. § 102

Applicant acknowledges the quotation of 35 U.S.C. § 102(e). Claims 1 and 2 stand rejected under 35 U.S.C. §102(e) as being anticipated by Daniels (U.S. 6,904,248).

It is well settled that "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration."¹ The single reference must also disclose each element of the claimed invention "as arranged in the claims."² It is not enough that the reference teach all the claimed elements in isolation, or in a different relation. Therefore, if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation cannot be found.³ Accordingly, Applicant respectfully submits that the Office has failed to provide a *prima facie* case of anticipation.

Applicant respectfully disagrees with the Office's assertion that Daniels teaches a toner cartridge having a waste bin with a leading end sculpted to mate with a plurality of printer families (Office Action, page 4). In distinction, Daniels teaches a method of altering one type of process cartridge to be converted to another by altering its physical characteristics (Col. 2, lines 22-26). The toner cartridge of Daniels can only be used in the single printer chosen prior to altering the toner cartridge.

¹ See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303,313 (Fed. Cir. 1983).

² See Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1542, 221 USPQ 481, 485 (Fed. Cir. 1984).

³ Donner, Irrah H; *Patent Prosecution; Practice and Procedure Before the U.S. Patent Office*; BNA Books, 1999

For example, Daniels describes "one conversion example" of "converting the Lexmark™ Optra S/SE/T style cartridge into a Lexmark™ T520/522" (Col. 1, lines 51-52). In this example the altered cartridge can only be used in the T520/522 printer family. Moreover, Daniels teaches a method of converting an HP4000™ toner cartridge to a HP4100™ (Col. 2, lines 1-3). However, Daniels does not teach a method of converting a single toner cartridge to a toner cartridge capable of use in *both printer families*. Succinctly, the modified cartridge of Daniels is not capable of being received in the receiving cavity of a *plurality of printer families* but merely a *different printer family*.

Applicant respectfully directs the Office's attention to the following passage from Daniels (emphasis added):

The present invention is accomplished when the indentation in the waste bin assembly, once *the plug* is inserted, is such that the cartridge as modified will into *a different printing device* than originally intended. *The plugs will vary in size and shape depending on the conversion being performed.*" (Col. 4, lines 50-55).

Daniels continues that "the T520/522 conversion plug 30 that is used to cover the recess created by this conversion process is illustrated in FIGS. 7A and 7B" (Col. 6, lines 54-56). This makes it clear that only a single plug, adapted to convert a cartridge to a single new-use, is used in the method of Daniels. In contrast, Applicant's toner cartridge is capable of being removed from a printer in one printer family and then being inserted into a printer in a different printer family without modification.

One embodiment of Applicant's cartridge, by way of example, is capable of use in the following printers *without modification*:

A leading end sculptured in the manner of Fig. 2A mates with Lexmark printer models Optra S 1250, Optra S 1255, Optra S 1620, Optra S 1625, Optra S 1650, Optra S 1855, Optra S 2420, Optra S 2450, Optra S 2455, Optra SE 3455, Optra T610, Optra T612, Optra T614, Optra T616, Optra T520, Optra T522, Optra T620, Optra T622, Optra T630, Optra T632, and Optra T634, with IBM printer models Infoprint 1120, Infoprint 1125, Infoprint 1130, Infoprint 1140, Infoprint 1332, Infoprint 1352, and Infoprint 1372, with Source Technology printer models ST915, ST920, ST925, ST935, ST9120, ST9125, ST9130, ST 9140, ST 9325, ST9335, and ST9340, with Unisys printer models UDS 9712, UDS9716, UDS9718, UDS9724, UDS3034, UDS15, UDS20, UDS25, UDS35, UDS130, UDS132, UDS134, UDS136, UDS140, and UDS142, with Toshiba printer

(Amendment A for USSN: 10/742,323 - Page 11 of 14)

models e-Studio20P, e-Studio25P, e-Studio30P, e-Studio 40P and e-Studio 400P, with Dell printer models M5200n and W5300n, Nashuatec P6220, Nashuatec P6225, Nashuatec P6230, and with the Nashuatec P6240.

As Daniels does not teach the elements of Applicant's invention as arranged in the claims it cannot anticipate. Accordingly, withdrawal of the rejection on these grounds is respectfully solicited. Claim 2 is dependent on claim 1, which has been shown to be patentable, and is therefore allowable as a matter of law.

Claim Rejections - 35 U.S.C. § 103

Applicant acknowledges the quotation of 35 U.S.C. § 103(a). Claims 3 through 13 stand rejected under 35 U.S.C. §103(a) as being anticipated by Daniels (U.S. 6,904,248). Claims 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Daniels in view of Huss et al. (6,018,636).

Claims 3 through 13, as well as claims 19 and 20, are dependent, directly or indirectly, on claim 1, which has been shown to be patentable, and are therefore allowable as a matter of law.

Applicant respectfully submits that the Office has not established a *prima facie* case of obviousness. MPEP §2143 requires the Office to demonstrate (1) a motivation or combination to combine the references; (2) a reasonable expectation of success; and (3) the prior art must teach or suggest all the claim limitations. As discussed above, Daniels does not teach or suggest a toner cartridge capable of being used in a plurality of printers but merely allows one cartridge to be modified "from one type to another." [Col. 4, line 17]

Applicant's disclosure is contrary to the understandings and expectations of the art. For example, in *Schenck v. Norton Corp.*⁴ the court found the claims patentable where the claimed invention eliminated the predicted requirements of the cited reference. In *Schenck* the prior art (directed to a vibratory testing machine) anticipated the need to dampen resonance. The court found the claims in question patentable because the claimed invention removed the need to dampen resonance which was contrary to the teachings of the cited reference.

Here, Daniels predicts that "[D]epending on the type of cartridge *and future application*, the plug may vary in size and shape." [Col. 2, lines 48-50]. In contrast, Applicant's invention can be used in the plurality of printers without modification. The different embodiments of

(Amendment A for USSN: 10/742,323 - Page 12 of 14)

Daniels describe how to convert one type of cartridge to one other. The different embodiments of Applicant's invention teach how to make a cartridge that fits into numerous printers.

Although it is well-settled that the rearrangement of parts that are mere design choices are *prima facie* obvious, where the rearrangement provides a specific and unexpected utility the limitations are patentable.⁵ Moreover, the rejection presented amounts to impermissible hindsight by the Office. Daniels provides no guidance to create a universal cartridge, nor of which parameters are critical in modifying a cartridge. Daniels is also silent as to any of the possible choices which would likely be successful as a universal cartridge. The cited reference provides guidance only in the one-to-one conversion of a pre-existing cartridge.⁶

As shown above, Daniels (alone or in combination) fails to support a case of *prima facie* obviousness. Moreover, claims 3 through 13, as well as claims 19 and 20, are dependent, directly or indirectly, on claim 1, which has been shown to be patentable, and are therefore allowable as a matter of law. Withdrawal of the rejection on these grounds is respectfully solicited.

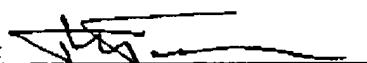
Conclusion

Entry of a Notice of Allowance is solicited. If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

By:


Thomas E. Toner
USPTO Reg. No. 57,422
Suite 220
15950 Bay Vista Drive
Clearwater, FL 33760
(727) 507-8558
Attorneys for Applicant

Dated: December 19, 2005

⁴ MPEP 4144.04(V)(B)

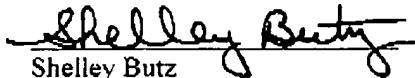
⁵ MPEP 2144.04(VI)(A)-(C)

⁶ See MPEP 2145 (X)(B)

CERTIFICATE OF FACSIMILE TRANSMISSION
(37 C.F.R. 1.8 (a))

I HEREBY CERTIFY that this Amendment A, Amendments to the Claims and Remarks are being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 2852, Attn: Sandra L. Brase, (517)273-8300, on December 19, 2005.

Dated: December 19, 2005


Shelley Butz

(Amendment A for USNN: 10/742,323 - Page 14 of 14)